

The specification provides defining context for the term "third device" in at least three locations. On page 5, lines 5-8, in the "Summary of the Invention" section, the specification uses language nearly identical to that of claim 5:

Further, in some embodiments, a secondary gate controller can send a message to the edge router indicating the failure of the gate controller. The edge router can update the call state information after receiving the message and use the secondary gate controller to support registration, admission, and status requests associated with the call.

Similarly, lines 14-25 of page 9 and lines 16-25 of page 18 through lines 1-6 of page 19 provide further enablement for claim 5. Because claim 6 depends from claim 5, the "third device" is defined similarly in claim 6 as it is in claim 5. Thus, Applicant respectfully submits that claims 5 and 6 satisfy the requirements of 35 U.S.C. § 112, first paragraph. Claim 7 is also properly enabled. In addition to the portions cited above with respect to claims 5 and 6, lines 9-12 of page 5 provide meaning for the "third device" by using nearly the same language of Claim 7:

In some embodiments, if the gate controller fails, a secondary gate controller is activated with the same Internet protocol address as the gate controller. In this embodiment, the failure of the gate controller should pass without any changes at the edge router.

Thus, while claims 5-7 are genus claims, in which the claim language speaks for itself, the preferred embodiment of the specification provides for a secondary gate controller to serve as the "third device." In light of this exemplary definition, Applicant respectfully submits that claims 5-7 satisfy the requirements of 35 U.S.C. § 112, first paragraph. The Examiner is requested to withdraw these rejections.

**Claim Rejections under 35 U.S.C. § 102(e)**

The Office Action rejected claim 12 under 35 U.S.C. § 102(e) as being anticipated by Kalmanek (U.S. Patent No. 6,324,279). Applicant notes that while the relevant paragraph of the Office Action (paragraph 2, beginning on page 3) initially cites Kalmanek and later refers to White, it appears that this is in error. Applicant will respond assuming the Office Action intended to cite Kalmanek throughout. For the reasons provided below, Applicant respectfully traverses the rejection.

The Office Action's combination of devices from Kalmanek differs from the invention described in claim 12 at least because the memory element is missing from the edge router. Instead, the Office Action refers to a memory located across an access network in a Telephony Interface Unit (TIU) 170. Such a configuration would not provide the scaling advantages of the invention of claim 12 because, instead of having a single memory with state information at the edge router, each telephone 190 requires a TIU 170 with its own memory. Thus, for an access network with many telephones 190, there would need to be many memories at TIUs 170. The billing and access control advantages realizable in some of the embodiments described in the Applicant's application would be questionable, due to the location of the TIUs 170 at points across a network from any back edge servers that may be present at, for example, a central office. Thus, Applicant respectfully submits that the Office Action's rejection of Claim 12 under 35 U.S.C. § 102(e) has been overcome.

**Claim Rejections under 35 U.S.C. § 103(a)**

The Office Action rejected numerous claims under 35 U.S.C. § 103(a). Applicant respectfully submits that the Office Action's § 103 rejections are improper because they

are each contrary to at least one of the following three basic tenets of patent law: (1) both the claims and the prior art references must be considered in their entirety (MPEP § 2141.02); (2) references can be combined only if some teaching, suggestion, or motivation to combine them can be found (MPEP § 2143.01); and (3) proposed modifications or combinations must not change the principle of operation of the prior art inventions (MPEP § 2143.01). Applicant's traversals referencing these improper rejections, where applicable, are described below, along with reasons why the combinations set forth in the Office Action do not result in the claimed inventions.

The Office Action rejected claims 1-3, 9, 11, 16, and 20-21 under 35 U.S.C § 103(a) as being unpatentable over White (U.S. Patent No. 6,069,890), and further in view of applicant's admitted prior art. The Office Action rejected claims 10 and 22 under 35 U.S.C § 103(a) as being unpatentable over White (U.S. Patent No. 6,069,890) and applicant's admitted prior art, and further in view of Newton (Newton's Telecom Dictionary, 14<sup>th</sup> Ed., Telecom Books, New York, 1998). The Office Action rejected claims 4, 8, and 17-19 under 35 U.S.C § 103(a) as being unpatentable over White (U.S. Patent No. 6,069,890), and further in view of Kalmanek (U.S. Patent No. 6,324,279). These rejections will be addressed together, since they all rely on Kalmanek as the dominant reference.

Applicant respectfully submits that the Office Action mischaracterizes White. White shows an early system for delivering voice over the Internet. The Office Action initially refers to the telephone 100 as being the "first device" of Applicant's claims and the telephone 118 as being the "second device." However, in applying the claim limitations associated with the first and second devices, the Office Action proceeds to

reference functionality associated with the telephone 100, a Local Exchange Carrier (LEC) 102, and a gateway router (see Office Action, page 4, last paragraph). Claim terms should have consistent meanings throughout a claim. Applicant respectfully requests clarification. What is being referred to as the "first device" and what is being referred to as the "second device." Inasmuch as Applicant is unable to see how any single device or combination of devices could be combined to read on Applicant's claims as the Office Action sets forth, the Applicant is unable to respond to the rejections utilizing White, other than to respectfully submit that a prima facie case of obviousness has not been made.

In addition, With the exception of the gateway router 104, most of the devices combined by the Office Action are legacy devices, operating under circuit-switched PSTN principles (see col. 7, lines 45-53). Applicant is unable to find any support in White for the Telephone 100 including any kind of non-POTS port, let alone an H.323 port. Similarly, other devices within the Office Action's combination of devices would have to be changed considerably to have the structure and functionality provided by Applicant's claimed devices. To modify the teachings of White to implement H.323 would destroy White's principle of using existing legacy components to make Internet calls.

Moreover, Applicant respectfully submits that many necessary details are missing from White, such as those relating to call state information, including where it is stored and how it is updated. Clarification is respectfully requested.

The Office Action rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Kalmanek (U.S. Patent No. 6,324,279), and further in view of Newton

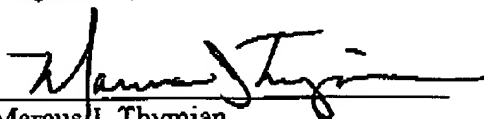
(Newton's Telecom Dictionary, 14<sup>th</sup> Ed., Telecom Books, New York, 1998). Claim 13 depends from claim 12. In light of the reasons for traversal stated with respect to Claim 12 above (Claim rejections under 35 U.S.C. § 102(e)), Applicant submits that claim 13 is also allowable. Newton fails to correct the shortcomings of Kalmanek, nor has the Office Action given any proper motivation to combine Kalmanek with Newton. The motivation provided in the Office Action is believed to be out of hindsight after seeing Applicant's application, since such a motivation is present in neither Kalmanek nor Newton. Regardless, because at least the memory limitation is missing from Kalmanek, as described earlier, and this shortcoming is not cured by Newton, claims 12 and 13 are both believed to be in allowable form and Applicant respectfully requests that this rejection be withdrawn.

#### Conclusion

In light of the above remarks, Applicant respectfully requests allowance. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at 312.935.2352.

Respectfully submitted,

Date: September 13, 2002



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